

# New Pre-Appeal Brief Conference Pilot Program

**Effective Date:** Effective upon publication of this notice

This new program offers applicants an avenue to request that a panel of examiners formally review the legal and factual basis of the rejections in their application prior to the filing of an appeal brief. Effective immediately, the USPTO is offering applicants an optional procedure to review the examiner's rejection *prior* to the actual filing of an appeal brief. The program is intended to spare applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal. Although this procedure will not be appropriate in every appealed application, in the proper situations it can save both the resources of the applicant and the Office. Applicants continue to have available to them the normal practice and procedures already in effect under Part 41 of the Title 37 of the Code of Federal Regulations relating to appeals and practice before the Board of Patent Appeals and Interferences.

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## 1. General Provisions:

### • *What is this program?*

Under the current practice every applicant whose claims have been twice rejected may appeal the examiner's decision to the Board of Patent Appeals and Interferences. To do so, the applicant first files a notice of appeal accompanied by the appropriate fee<sup>i</sup> within the appropriate time period<sup>ii</sup>. Within two months from the date of the filing of the notice of appeal, applicant must file an appeal brief accompanied by the appropriate fee<sup>iii</sup>. Applicants may buy extensions of time for filing the appeal brief.

This pilot program offers applicants an opportunity to request a review of identified matters on appeal employing an appeal conference currently employed in the Office, but prior to the filing of an appeal brief. The goals of the program are (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the omission or presence of essential elements required to establish a *prima facie* rejection.

### • *Who can use this program?*

Any applicant who has filed a notice of appeal and who wants a panel of experienced examiners to perform a detailed review of appealable issues within a set period of time.

### • *How to decide if you should request this panel review?*

If the applicant feels the rejections of record are clearly not proper and are without basis, then filing this request may result in a panel decision that eliminates the need to file an appeal brief. This should be based upon a clear legal or factual deficiency in the rejections rather than an

interpretation of the claims or prior art teachings. The latter is more appropriate for the traditional appeal process currently employed by applicants.

- *What happens during a panel review?*

A panel of examiners (including the examiner of record) will consider the merits of each ground of rejection for which appeal has been requested and will issue a written decision as to the status of the application.

- *When should you file an appeal brief or other correspondence?*

This program is designed to allow applicants who think there is a clear deficiency in the prima facie case in support of a rejection to file the request at the same time that they file a notice of appeal. This affords the Office the best opportunity to ensure that applicant will promptly receive a decision on the request. If the request is filed with the notice of appeal, the period of time for filing the appeal brief will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.

- *What actions will terminate the panel's review?*

If applicant files any of the following responses after filing a request, but prior to a decision by the appointed panel of examiners assigned to conduct the review, the review process will end and a decision will not be made on the merits of the request:

- an appeal brief
- a request for continued examination (RCE)
- an after-final amendment
- an affidavit or other evidence
- an express abandonment

A request for the declaration of an interference will also result in an end to the review process. Applicant will be promptly notified by an Office communication of termination or of dismissal of the request. If any of the above-noted actions occur, the period for filing the appeal brief (if applicable) will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.

## **2. Conditions Necessary to Request a Panel Review:**

- Applicant must file a notice of appeal in compliance with 37 CFR 41.31.
- Applicant must file the request with the filing of a notice of appeal and before the filing of an appeal brief.<sup>1</sup>
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## **3. Content of Request:**

- a. File the request and accompanying arguments in a separate paper entitled, “Pre-Appeal Brief Request for Review”. A sample request form has been created and is available on the USPTO Internet Website, on the forms page, as PTO/SB/33.
- b. In five (5) or less total pages, provide a succinct, concise and focused set of arguments for which the review is being requested.
- c. File the request with the notice of appeal.

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<sup>1</sup> Under this pilot program, the request must be filed with the notice of appeal. The Office is considering, as part of a more permanent implementation of the pre-appeal brief conference program, permitting applicants to file the request within two months (non-extendable) of the receipt of the notice of appeal for a fee (\$130.00), in which case the period for filing an appeal brief would simply be the two-month period set in 37 CFR 41.37(a) (i.e., the mailing of a decision on the request would not provide any new time period for filing the appeal brief). This procedure would be included to encourage applicants to file the request with the notice of appeal and thereby provide the best opportunity for the Office to provide the decision in a timely manner.

- d. Address the notice of appeal and the request to
  - Mail Stop AF
  - Commissioner for Patents
  - P.O. Box 1450
  - Alexandria, VA 22314\_\_\_\_\_
  - Fax the notice of appeal and the request to the Central FAX Number (now 571 273-8300)
  - Hand carry the notice of appeal and the request to the  
USPTO Customer Service Window, ATTN: Mail Stop AF  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314
- e. No after-final or proposed amendments may accompany the request.<sup>iv</sup>

A request that fails to comply with the above noted submission requirements may be dismissed.

#### **4. Content of Remarks or Arguments:**

The request should specify –

- clear errors in the examiner’s rejections; or
- the examiner’s omissions of one or more essential elements needed for a *prima facie* rejection.

For example, the request should concisely point out that a limitation is not met by a reference or the examiner failed to show proper motivation for making a modification in an obviousness rejection (35 U.S.C. 103). Applicants are encouraged to refer to arguments already of record rather than repeating them in the request. This may be done by simply referring to a prior submission by paper number and the relevant portions thereof (*e.g.*, see paper number 3 at pages 4 to 6). However, references such as “see the arguments of record” or “see paper number X” are not helpful and will just obfuscate the real issues for review.

The request may not be more than five (5) pages total and the remarks should be drafted with the expectation that for a clear error in fact or other deficiency, a long detailed explanation is not needed. **Requests are limited to appealable, not petitionable matters.**

Any actual issues lacking factual basis, including interpretations of the prior art teachings or claim scope as contrasted with clear error in facts, are appropriate for the traditional appeal process and submission of the appeal brief. For grounds where a clear issue on proper interpretation exists, applicant is advised to proceed to appeal with the timely filing of the appeal brief. This program is not intended to be, and is not, an alternative for filing an appeal.

#### **5. USPTO Consideration of the Request:**

Upon receipt of a properly filed request, a Technology Center Art Unit supervisor will designate a panel of examiners experienced in the field of technology to review the applicant’s remarks and the examiner’s rejections. The panel will include at least a supervisor and the examiner of record. The applicant will **not** be permitted to attend the review and **no** interviews will be granted prior to issuance of the panel’s decision.

The panel members will review the rejection(s) identified by applicant in the request. They will also review the application and the appropriate evidence in support of the rejections to the extent

necessary. The panel will then decide if an issue for appeal is, in fact, present in the record. The Office should mail a decision within 45 days of receipt of a properly filed request.

## **6. Format of Panel Decision:**

After the review is complete, the Office will mail a decision on the status of the application. The decision will state one of the following:

- Finding 1: The application remains under appeal because there is at least one actual issue for appeal.
- Finding 2: Prosecution on the merits is reopened and an appropriate Office communication will follow in due course. In appropriate circumstances, a proposed amendment may accompany the panel's decision proposing changes that, if accepted, may result in an indication of allowability for the contested claim(s).
- Finding 3: The application is allowed on the existing claims and prosecution remains closed.
- Finding 4: The request fails to comply with the submission requirements and is dismissed.

The decision will summarize the status of the pending claims (still rejected, withdrawn rejections, objected to or allowable claims).

A decision by a pre-appeal brief conference panel to withdraw the rejections of any or all of the claims on appeal is not a decision by a panel of the Board of Patent Appeals and Interferences, and, as such, would not result in any patent term extension of adjustment under 35 U.S.C. § 154(b) (37 CFR 1.701(a)(3) and 1.702(e)).

The decision will not contain any additional grounds of rejection or any restatement of previously made rejections. Such matters will be addressed, as appropriate, in the Examiner's Answer.

## **7. Time Periods Before / After a Panel Decision:**

- The request must be filed with the filing of a notice of appeal and before the filing of the appeal brief. No extensions of time are available for filing the request for review.
- The time period for filing an appeal brief will be reset to be one month from mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of the decision on the request or the receipt date of the notice of appeal, as applicable. To the extent that any existing USPTO rule is inconsistent with this pilot program, the rule is waived until regulations directed to pre-appeal brief conferences are promulgated, or the pilot program is ended. For example, if a request for a pre-appeal brief conference is filed with a notice of appeal, the time period set in 37 CFR 41.37(a)(1) is waived so that an appeal will not stand dismissed if an appeal brief is not filed within two months of the filing date of a notice of appeal, but is filed within one month of the decision on the request.

Applicant's period for filing the appeal brief or other appropriate response ends on the mailing date of a panel decision that indicates all claims are allowed or that prosecution is reopened.

#### **8. Administrative Matters:**

- Applicants should ensure that requests are mailed or faxed with the notice of appeal to ensure timely filing. The request should contain a certificate of mailing or transmission under 37 CFR 1.8 and be listed on any postcard receipt (MPEP 503).
- No supplemental requests or arguments will be accepted.
- The notice of appeal fee is not refundable, even in the event of a decision favorable to applicant.
- A request filed after the date of receipt of the notice of appeal will be dismissed as untimely.
- This procedure does not affect petitions to invoke supervisory authority under 37 CFR 1.181 because such petitions address procedural matters, not appealable, matters.
- Panel decisions will not be petitionable because a decision to maintain a rejection is subject to appeal.
- A pre-appeal brief conference panel decision that the application remains under appeal is not final agency action for purposes of court review. An applicant dissatisfied with the result of the appeal conference must pursue the appeal before the Board of Patent Appeals and Interferences.
- This process does not apply to reexamination proceedings.
- Following a panel review under this pilot program, the examiner retains the option to reopen prosecution or to allow an application after the filing of an appeal brief. This unlikely situation might arise, for example, where new arguments or evidence are presented in the appeal brief.
- This pilot program will run for at least six months from its effective date. The Office may extend, terminate, revise or otherwise take appropriate action after evaluating its effectiveness at the end of that period. If the program is to be made permanent, the Office will promulgate the appropriate changes to title 37 of the Code of Federal Regulations.

Please direct inquiries with respect to a pending request for a pre-appeal brief conference to the examiner to whom the patent application is assigned, or the examiner's immediate supervisor. Please direct comments and inquiries on this pilot program to Anton Fetting via email addressed to [anton.fetting@uspto.gov](mailto:anton.fetting@uspto.gov). You may also contact Mr. Fetting at (571) 272-7701.

/s/

JOSEPH J. ROLLA

Deputy Commissioner for  
Patent Examination Policy

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<sup>i</sup> Set forth in 37 CFR 41.20(b) (1)

<sup>ii</sup> See 37 CFR 1.134

<sup>iii</sup> Set forth in 37 CFR 41.20(b) (2)

<sup>iv</sup> 37 CFR 41.33(a)